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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,888	03/28/2006	Shunichi Oshima	IXIO125793	8350
26380 7590 12/08/2008 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347				
EXAMINER				
WORJLOH, JALATIE				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
12/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/542,888

**Applicant(s)**

OSHIMA ET AL.

**Examiner**

Jalatee Worjloh

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 1-18-2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on November 18, 2008 is acknowledged.

2. Claims 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on November 18, 2008.

3. Claims 1-4 and 8-13 have been examined.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0095587 to Doyle et al. ("Doyle") in view of US Patent No. 6098053 to Slater.

Referring to claim 1, Doyle discloses confirming the identity of a user by using a portable electronic device having a fingerprint sensor to read the user's fingerprint and check the reading against pre-registered fingerprint data to determine whether or not the user is the owner of said portable electronic device having a fingerprint sensor (see paragraphs [0035] & [0036]). Doyle does not expressly disclose if the user is confirmed as the owner of the portable electronic device having a fingerprint sensor, using said portable electronic device having a fingerprint sensor to

encrypt commodity order information and pre-registered card information using a pre-registered transmission public key to generate transaction data, and electronically sign the generated transaction data using pre-registered personal encryption key, transmitting said electronically signed transaction data from said portable electronic device having a fingerprint sensor to said card management system; and at said card management system, decrypting said electronically signed transaction data using a transmission secret key paired with said transmission public key to obtain said commodity order information and settle purchase charges associated with said commodity order. Slater discloses encrypting commodity order information and pre-registered card information using a pre-registered transmission public key to generate transaction data (see col. 7, lines 66-67 and col. 8, lines 1-28), and electronically sign the generated transaction data using pre-registered personal encryption key (see col. 8, lines 52-54), transmitting said electronically signed transaction data from said portable electronic device to said card management system ; and at said card management system, decrypting said electronically signed transaction data using a transmission secret key paired with said transmission public key to obtain said commodity order information and settle purchase charges associated with said commodity order (see col. 10, lines 32- 46). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Doyle to include the concept taught by Slater. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security and prevents unauthorized transactions.

Although the conditional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted.

See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]".

Referring to claim 2, Dolye in combination with Slater disclose said pre-registered fingerprint data and said pre-registered card information are registered in a state in which they are encrypted by a storage public key provided by said card management system (see claim 1 above).

Referring to claim 3, Doyle in combination with Slater disclose using a portable electronic device having a fingerprint sensor according to claims 1 or 2, wherein said card management system stores and retains the received electronically signed transaction data for a predetermined time period (see claim 1 above).

Claims 8-10 are rejected on the same rationale as claims 1-3 above.

6. Claims 4, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle and Slater in view as applied to claims 2 and 9 above, and further in view of US Publication No. 2003/0050900 to Kuraishi.

Referring to claim 4, Doyle in combination of Slater teaches the method of claim 2. However, Doyle fails to teach updating said pre-registered transmission public key and said storage public key and replacing said pre-registered card information and said pre-registered fingerprint data with updated pre-registered card information and updated pre-registered fingerprint data encrypted using said updated storage public key. Kuraishi discloses of updating fingerprint data and card information stored on a card (see paragraph [0113]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify

the method disclose by Doyle to include the concept taught by Kuraishi. One of ordinary skill in the art would have been motivated to do this because it ensures that the data stored on the card is always accurate.

Claims 11-13 are rejected on the same rationale as claim 4 above.

Although Applicant(s) use “means for” in the claim(s) (e.g. claim 8-12), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. §112 6<sup>th</sup> paragraph should not be invoked. Alternatively, if Applicant(s) desire to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6<sup>th</sup> paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*.<sup>1</sup> Failure by Applicant(s) in their next response to also address the 35 U.S.C. §112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. §112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

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<sup>1</sup> Federal Register, Vol 65, No 120, June 21, 2000.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685